

Serial No. 10/542,399
Amendment Dated June 18, 2007
Responsive to Office Action dated May 9, 2007

REMARKS/ARGUMENTS

Claims 1-19 are pending.

Claims 1-13 were rejected under 35 U.S.C. 102(b) as being anticipated by Haber (US 4,103,773). The rejection is traversed.

The rejection was not a proper claim rejection under 35 U.S.C. 102(b), which requires that each and every claim element be found in the cited prior art reference, i.e., Haber. However, original claim 1 provided:

the hopper and tray being further configured to keep the golf balls stacked in the truncated pyramidal shape

Since Haber's device is only capable of keeping POOL balls stacked as opposed to GOLF balls whose dimension is smaller than pool balls, it is clear that Haber does not meet this claim rejection and the rejection under anticipation was improper.

Indeed, claim 1 further provides that the respective surface of the hopper and tray

each being of a dimension to stably self-support, and without toppling, the hopper and tray in the closed position as either of the surfaces rests on a flat, horizontal surface

Even if one were to replace the pool balls of Haber by golf balls, there is no way that the dimension of Haber's assembly would enable flipping the Haber assembly upside down and yet stably self support, without toppling, the assembly while the raised triangular surface 24 of Haber rests on a horizontal surface. As

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can be seen in Fig. 4 of Haber, there are gaps around each of the pool balls so that they are free to displace out of the openings 17, 21 should the assembly be flipped over. By replacing the pool balls by golf balls, which are inherently smaller in size, the golf balls are even freer to move about since nothing keeps them positioned anyway due to the even larger gaps when the assembly is inverted upside down. Thus, the assembly would inherently become unstable and topple and thus not meet the claim recitation. As such, anticipation is clearly not made out.

Therefore, the next Office Action may not properly be made final.

In addition, the Office Action failed to provide a comparison between Haber and each of the dependent claims. Such a deficiency is further grounds for finding that anticipation under 35 USC 102(a) was not *prima facie* made out.

For instance, claim 8 recites dimples, but no effort was made in the Office Action to identify counterparts to the dimples in Haber to justify the anticipation rejection. Claim 12 calls for a spacer and claim 13 calls for the spacer to have a lid, but no effort was made in the Office Action to identify counterparts to the spacer and lid in Haber to justify the anticipation rejection. As such, claims 8, 12 and 13 were clearly never examined on the merits properly, which means the next Office Action may not properly be made final since they clearly are not anticipated.

Nevertheless, claim 1 was amended to clarify the invention, even though there was no need to do so to overcome Haber.

There are two distinctions.

The first, as previously mentioned, concerns the dimension and configuration of the inner cavity that, in the case of the present claims, accommodates stacking of layers of golf balls in a stable manner that define a pyramidal shape. In contrast,

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the packaging enclosure of Haber accommodates pool ball stacks, albeit with the aide of openings in the bottom and intermediate trays for stability, but could not stably support layers of golf balls stacked in a pyramidal manner.

Second, Haber describes its raised triangular surface 24 as being for “aesthetic purposes”. As such, a skilled artisan would not expect it to be reliable for stably supporting pool balls if the assembly were flipped so that the small triangular surface 24 were resting upon a horizontal surface. Consider further that the pool balls in Haber rest in openings 17, 21. As best seen in Fig. 4 of Haber, the pool balls not only touch each other, but there are spatial gaps above them underneath the surface above. Thus, if flipped, the gap allows the pool balls to leave the openings due to gravity and roll to the side to some extent and more likely than not to upset the balance and topple the assembly. It is uncertain whether the raised triangular surface 24 will support the weight of the pool balls or is oriented to stably support them when the assembly is flipped over.

In contrast, claim 1 recites that the hopper and tray are configured so that resting each of the respective surfaces one at a time upon a horizontal surface stably supports the hopper and tray in the closed position without toppling.

The remaining claims are patentable in their own right.

As concerns claim 2, there are no complementary configurations on the top and bottom trays of Haber.

As concerns claim 3, Haber mentions that there is a fastening means 12 on the bottom tray that engage with counterpart of the top tray, but there is no mention of any fastening with the intermediate tray that supports the top layer of pool balls. Indeed, the top tray serves no role in supporting any of the pool balls, which instead rest in openings in the bottom and intermediate trays. Claim 2

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calls for the hopper and tray to have retainers that engage each other, but the hopper and tray are described in claim 1 as stably supporting the golf balls that are stacked. In contrast, the top tray of Haber plays no role in stably supporting pool balls and the intermediate tray of Haber lacks retainers that are to engage with counterparts in the base tray. In effect, the present invention performs with just two pieces (hopper and tray), which Haber tries to accomplish with three pieces (bottom, intermediate and top trays).

As concerns claim 4, Haber lacks complementary indentations and configurations suited to complement each other.

As concerns claim 5, bringing the intermediate and bottom trays together do not cause the fasteners of the top and bottom trays to slide against each other.

As concerns claim 6, Haber provides for an elongated tongue 31 passing through a slot 30 to form an effective hinge between the top and bottom trays, but, contrary to the recitation of claim 1, the top tray of Haber plays no role in stably supporting ball stacks within. Such is done by the bottom and intermediate layers of Haber, but he intermediate layer lacks any hinge component.

As concerns claim 7, Haber's effective hinge arrangement may enable swinging about it, but there is no spring bias imposed upon the hinge.

As concerns claims 8 and 9, Haber lacks dimples.

As concerns claim 10, nothing in Haber suggests that one might stably stack duplicate combination packages one atop the other in the closed position without toppling. Further, Haber lacks complementary indentations and configurations.

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As concerns claim 11, Haber lacks an indentation for its bottom tray that complements a configuration on the top tray.

As concerns claims 12 and 13, Haber lacks spacers and lids.

As concerns claim 14, not only does Haber lack dimples, but there is no mention that in Haber such dimples have a concave or convex curvature.

New claim 17 recites the orientation of sidewalls, which are evident in the drawings. Haber's pool ball packaging device has three parts: a bottom tray 14 with downwardly depending sidewalls 15 (col. 2 lines 25-26), an intermediate tray 18 having downwardly depending sidewalls 19 (col. 2 lines 33-34), and a top tray 22 having downwardly depending sidewalls 23 (col. 2 lines 41-43). The bottom and intermediate trays 14, 18 have respective series of openings 17, 21 to hold individual ones of the pool balls.

In contrast, claim 17 recites that the hopper and tray each have sidewalls that terminate in peripheries and that the sidewalls engage each other at a location spatially between the two parallel planes (in which lie the respective surfaces of central regions of the hopper and tray). Fig. 3 of Haber, however, shows the mouth of each of the trays nested one within the other at the base level, as seen in Fig. 2. Thus, rather than joining each other at a location spaced intermediate from parallel planes that extend through top and bottom surfaces of the assembly, they are in alignment with the bottom plane. Such an arrangement in Haber for instance, does not lend it self to a clamshell type construction, such as is recited in claim 18.

Finally, it is noted that since Haber constitutes non-analogous art (pool balls packaging), it may not be properly modified by any prior art to justify a 103 rejection. It was not designed to address any golf ball storage problem

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comparable to that faced by the present invention. Indeed, the pool balls themselves in Haber are not envisioned to touch each other when balls are individually placed in appropriate openings as is clear from Fig. 4 of Haber. There is no stable stacking of pool balls in Haber without making provision for its intermediate tray, which intermediate tray is not needed in the present invention.

Reconsideration and allowance are earnestly solicited.

Respectfully submitted,



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